

REMARKS

Examiner Hamdan is thanked for the courtesies extended during the Office Interview on September 1, 2004. The Interview Summary is believed to be a complete and proper summary of what was discussed at the Interview.

Reconsideration of the rejection of Claims 3, 4, 15-17 and 22 under 35 U.S.C. §112, first paragraph, is hereby requested. Claims 3, 15, and 22 have been amended. Claims 3 and 15 have been amended to include the phrase “determining the position of the object relative to the printer”. Claim 22 has been amended to include the phrase “to determine the cycle position of the printer relative to the container”. Therefore, reconsideration of this rejection is hereby requested.

Reconsideration of the rejection of Claims 3, 4, 15-17 and 22 under 35 U.S.C. §112, second paragraph is hereby requested. Claims 3 and 15 have been amended to reflect that what is being determined is the position of the object relative to the printer. Claim 22 has been amended to reflect that what is being determined is the cycle position of the printer relative to the container. Therefore, reconsideration of this rejection is hereby requested.

Reconsideration of the objection to the Drawings is hereby requested. Applicant respectfully asserts that the limitations about the position of the printer of Claims 3 and 15 are shown in Figure 9 and supported by the Specification on page 7 at lines 4-28. Therefore, reconsideration of this objection is respectfully requested.

Reconsideration of the rejection of Claims 1, 2, 5-9, 14-16, 18-19, 24-25 and 28 under 35 U.S.C. §102(a) (Applicant believes this should have been 102(b)) as being anticipated by McKillip (U.S. Patent No. 6,389,971), is hereby requested. Claims 1 and 14 have been amended. Claim 1 recites:

An apparatus for applying a label to an object, such as a container or cup, the apparatus comprising

a printer,

a label applicator coupled to the printer,

a holder configured to engage the object and move the object relative to the printer and the label applicator, the label applicator configured to apply a label to a surface of the object when the object is disposed near the label applicator, and the printer configured to print an image on the same surface of the object when the object is disposed near the printer, and

a control system coupling the printer and the label applicator to coordinate the printing of the object such that the label is in a predetermined position relative to the printed image (emphasis added – represents amendment).

Claim 14 recites:

A method of applying a label to an object such as a container or a cup carried by a holder, the method comprising the steps of

- positioning an object on a holder,
- providing a printer,
- providing a label applicator that is coupled to the printer,
- moving the object-carrying holder to a position proximate to both the printer and the label applicator,
- applying a label to a surface of the object with the label applicator while the object is on the holder, and
- printing an image on the same surface of the object with the printer while the object is on the holder (emphasis added represents amendment).

Applicant respectfully asserts that McKillip does not disclose all of the limitations of Claims 1 and 14. More particularly, in Claim 1: "...the label applicator configured to apply a label to a surface of the object..., and the printer configured to print an image on the same surface of the object...", and in Claim 14: "applying a label to a surface of the object..., and printing an image on the same surface of the object...". Regarding Claims 18 and 24, Applicant respectfully asserts that McKillip discloses neither "a printer configured to apply an image to a container" (Claim 18) nor "a machine for printing images on containers" (Claim 24). McKillip does disclose a business form printer but does not disclose a container printer. As defined in "Merriam-Webster's Collegiate® Dictionary-Tenth Edition", a container is defined as: "one that contains; esp: a receptacle (as a box or jar for holding goods)". The machine in McKillip prints an image on a first surface of one side of a business form and applies an adhesive patch to a second or different surface on an underside of the business form. Moreover, even if one stretched credulity and arguably called the business form a container (a concept Applicant strongly disagrees with), one of ordinary skill in the art

would not apply an adhesive patch (or label) to the inside surface of a container, especially since McKillip teaches placing a patch on the underside of a business form. That inside surface being the underside of the outside surface of the container. Therefore, reconsideration of this rejection is respectfully requested.

Reconsideration of the rejection of Claims 29-30 and 33 under 35 U.S.C. §103(a) as being unpatentable over Vander Griendt et al. (U.S. Patent No. 4,892,184) in view of McKillip (U.S. Patent No. 6,389,971) is hereby requested. Applicant acknowledges that Vander Griendt et al. does disclose a container printer. However, Applicant asserts that the secondary reference (McKillip) does not disclose “the combination of a container printer and label applicator” as alleged in the Office Action on page 10, lines 8-9. McKillip does disclose a business form printer that prints on a surface on one side of a business form and applies an adhesive patch to a different surface on an underside of the business form. Thus, Applicant asserts that there is no suggestion or motivation to use the teaching of McKillip to modify the device disclosed in Vander Griendt et al. to provide a label applicator on the device of Vander Griendt et al. when McKillip does not address a container environment. Further, one of ordinary skill in the art would not apply a label to an inside surface of a container especially since McKillip teaches placing a patch on the underside of a business form. Therefore, reconsideration of this rejection is respectfully requested.

As stated in the Office Action, Claims 4, 11, 23, 27 and 32 are allowable if rewritten to overcome the rejections under 35 U.S.C. §112, first and second paragraphs, and rewritten in independent form including all of the limitations of their respective base claims and any intervening claims. Claim 3 (from which Claim 4 depends) and Claim 22 (from which Claim 23 depends) have been amended to overcome the rejections under 35 U.S.C. §112, first and second paragraphs. Claims 4, 11, 23, 27 and 32 have been rewritten in independent form as new Claims 34-38, respectively, including all of the limitations of their respective base claims and any intervening claims.

Applicant respectfully submits that independent Claims 1, 14, 18, 24, 29 and 34-38 are now in condition for allowance, and such is respectfully requested. Also dependent Claims 2-13, 15-17, 19-23, 25-28 and 30-33 are considered as in condition for allowance for at least the same reason as their respective independent claims as well as for their additional limitations, and such is respectfully requested.

Examiner Hamdan is thanked for the phone call on September 3, 2004 bringing to Applicant's attention the following references: U.S. Patent Nos. 5,753,350; RE 28732; and, 5,569,351. We have reviewed these references and do not believe they affect the patentability of any of the claims.

In view of all of the above, Claims 1-38 are now in condition for allowance, and such is hereby requested.

In view of all of the above, the Application is now deemed to be in condition for allowance and such is respectfully requested.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 (5723-68359).

Respectfully submitted,
BARNES & THORNBURG LLP



Richard P. Krinsky
Registration No. 47,720
(202) 289-1313

RPK/cu

Attachment:

Claim Summary Document
Petition for One-Month Extension of Time

82350